



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,020	12/26/2000	Koichi Awano	001740	3284

23850 7590 07/28/2004

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,020

Applicant(s)

AWANO, KOICHI

Examiner

Ella Colbert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4 are pending.

Claim Objections

2. Claims 1-4 are objected to because of the following informalities: Claim 1, line 1 reads "... system by a debit card use comprising". This would be better read "... system using a debit card comprising". Claims 2 and 4 have a similar problem. Claim 3, line 1 has the same problem as for claims 1 and 2. Claim 3, lines 4 and 6 read "means for inputting or reading a settlement data to be paid to said ...; means for storing a balance data obtained by subtracting said ". These lines would be better read "means for inputting or reading settlement data to be paid to said ...; means for storing balance data obtained by subtracting said ". Claim 4 line 6, page 17 reads "means for permit withdrawing money when said identification number". This line would be better read "means for permitting withdrawing money when said identification number". This Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 line 2 reads "reader/writer unit installed in a store, said reader/writer unit". Does Applicant mean "reader or writer unit installed in a store,

Art Unit: 3624

said reader or writer unit" or "reader and writer unit installed in a store, said reader and writer unit"? Applicant is respectfully requested to clarify in the claim language.

Claim 4, page 17, lines 6 and 7 read "... is proper and for making said prepaid card having the balance invalid." This claim limitation is vague and unclear as to what Applicant means by "making prepaid card having the balance invalid. Clarification in the claim language is respectfully requested in order to give the claim a proper examination.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1- 4 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,003,762) Hayashida.

As per claim 1, Hayashida teaches, A card settlement system by a debit card use comprising means for issuing a prepaid card by using a debit card having a money withdrawal function (col. 1, lines 14-16); means for transmitting a settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued (col. 1, lines 61-67, col. 3, lines 15-58, and col. 4, lines 13-15); and means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data (col. 5, lines 51-61, col. 8, lines 56-67, and col. 9, lines 1-23).

As per claim 2, Hayashida teaches, A card settlement system by a debit card use according to Claim 1, wherein said prepaid card stores not an amount of money having a cash function but credit grant information indicative of a usable amount (col. 3, lines 50-57).

As per claim 3, Hayashida teaches, A card settlement system by a debit card use including a reader/writer unit installed in a store, said reader/writer unit comprising: means for inputting or reading a settlement data to be paid to said store by using a prepaid card storing credit grant information (col. 3, lines 62-67 and col. 4, lines 1-16); means for storing a balance data obtained by subtracting said settlement data from said credit grant information or a balance previously obtained (Col. 14, lines 10-50 and Fig. 12 (m12 & m19). ; and means for transmitting said settlement data to a settlement bank through a store's bank with which said store has an account (col. 15, lines 10-49).

As per claim 4, A card settlement system by a debit card use including an ATM of a settlement bank, said ATM comprising: means for issuing a prepaid card by using a debit card having a money withdrawal function (col. 3, lines 16-49); means for inserting a prepaid card having a balance and a cash card into said means for inputting an identification number (col. 12, lines 14-23 and fig. 9 (811)); and means for permit withdrawing money when said identification number is proper and for making said prepaid card having the balance invalid (col. 12, lines 27-46).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Muehlberger et al (US 5,696,908) disclosed using telephone debit cards which permits card payment in cash and credit.

Risafi et al (US 6,473,500) disclosed using a prepaid card to purchase a card issued by an issuer such as a bank.

Taskett (US 5,988,509) disclosed a prepaid transaction instrument such as a prepaid telephone card.

Flitcroft et al (US 6,636,833) disclosed a credit card system.

Franklin et al (US 5,883,810) disclosed an online commerce card.

Hayashida (US 6,257,487) Disclosed an electronic cashless system and a prepaid card or debit card.

Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
July 24, 2004